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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/301,656	04/28/1999	KINYA WASHINO	FNI-01503/03	5893

7590 04/01/2005

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BIRMINGHAM, MI 48009

EXAMINER
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DIEP, NHON THANH

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/301,656

Applicant(s)

WASHINO ET AL

Examiner

Nhon T Diep

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-74 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 28 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 30 is objected to because of the following informalities: Part of claim 30 is unreadable. Appropriate correction is required.
2. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.
3. A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

There is no consent for reissue discovered in the reissue application. The 3.73(b) statement is defective. According to Palm, there was an assignment made and recorded in the Office prior to the 3.73(b) from one of the applicants. Therefore, there needs to be a consent (item #1 above) and there must be also the establishment of the assignee in accordance with 3.73(b) by the actual assignee.

4. The separate declarations of Washino and Schwab are defective for failing to meet all the requirements under §1.63. For example, each declaration must list all inventors, addresses, citizenships, willful false statement, etc. You can have two separate declarations, just so long as the information for each inventor is listed on both and each inventor signs a copy. Please check with form PTO/SB 51 on the USPTO web site.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 70-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 70, line 3 recites the limitation "the" in "the camera". There is insufficient antecedent basis for this limitation in the claim.

7. Claims 1-7 and 17-18 are rejected as being based upon a defective reissue under 35 U.S.C. 251 as set forth below. See 37 CFR 1.175.

The nature of the defect(s) in the problem of recapture is set forth in the discussion below in this Office action.

There is the problem with recapture: (a) claim scope that was canceled or amended during the original prosecution is deemed surrendered and therefore barred from reissue; and (b) a reissue claim that entirely omits any limitation that was added/argued during the prosecution to overcome an art rejection, is impermissible recapture.

Based on the above analysis, we have impermissible recapture in this case.

i. Under the first analysis of recapture, during the prosecution of the parent application, a preliminary amendment was submitted which included an amendment to originally presented claim 1. On July 1, 1996, an Office Action was mailed which rejected claim 1 as being anticipated by Cash. Subsequently, Applicants filed an amendment on October 7, 1996 which incorporated then allowed claim 9 into claim 1. This amendment altered the system of claim 1 to now include two forms of high-capacity storage media with a further description of each. This means the original and

preliminary amendment subject matter with respect to claim 1 was surrendered by the filing of the October 7, 1996 amendment. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution. Claim 17 is directed towards a video storage system, i.e., dividing the subject matter of patent claim 1. Given that the amendments presented in the original Patent application were directed towards a computer and the high capacity storage media, then it is improper recapture for Applicants to revert back to the original and/or preliminary amendment versions of the storage media. In other words, Applicant is removing a limitation which was added in order to distinguish the claims from the prior art of record.

ii. Regarding the second analysis, Original claim 1 was directed to a video storage and display system whereby the system comprised a high-capacity storage medium. The October 7, 1996 amendment modified this limitation to now disclose two forms of high-capacity storage medium. By removing this recitation of two forms of high-capacity storage medium without adding a broader version of that limitation, constitute improper recapture. Claim 18 of the reissue, if incorporated into claim 17, would be proper given that it refers back to two forms of storage. (Applicant does not have to have the exact same limitation which was added in the amendment of October 7, 1996. However, there must be some version which refers to two forms of high-capacity storage.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon T Diep whose telephone number is 571-272-7328. The examiner can normally be reached on m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris S Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ND  
3/30/2005

A handwritten signature in black ink, appearing to read 'Nhon T Diep', with a long horizontal line extending from the end of the signature.

**NHON DIEP  
PRIMARY EXAMINER**